

GOBLE

Serial No. 10/036,500

Page 11

REMARKS

Claims 31-47 are pending in the application, Upon entry of this Amendment, claims 34, 39, and 44 will be amended.

The Examiner is thanked for indicating, in the outstanding Office Action of January 6, 2004, that objected to claims 34, 39 – 42, and 44 – 47 would be allowable if rewritten in independent form to include the base claim and any intervening claims. Such claims have now been so amended. Accordingly, because such claims should now be in condition for allowance, the Examiner's objections should be withdrawn, and no further comments regarding these claims will be made in this Amendment.

In the outstanding Office Action, the Examiner also rejected claims 31, 32, 33, 35, 37, 38, and 43 under 35 U.S.C. §103(a) as being unpatentable over Eggers (U.S. Patent No. 6,224,592) in view of Hart *et al.* (U.S. Patent No. 5,848,992). The Examiner further rejected claim 36 under 35 U.S.C. §103(a) as being unpatentable over Eggers ('592) in view of Hart *et al.* ('992) and further in view of Eggers (U.S. Patent No. 6,045,532) . The Examiner's rejections are respectfully traversed.

For a claimed invention to be obvious over a combination of prior art references, there must be some suggestion, motivation, or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985).

Independent claim 31 of the present application, the only independent claim that stands rejected in the outstanding Office Action, recites a method of treating a tumour

in a colon using an electrosurgical system wherein a space in the colon within which the tumour to be treated is located, and within which at least the active electrode of the electrosurgical system is located, is enclosed in a substantially fluid-tight manner. As noted at page 25 of the present application, key advantages of the claimed treatment method are that (1) the tumour is vaporised once the blood supply (mesentery) and lymphatics have been disconnected, (2) the tumour and the surrounding colon can be removed without spillage of any tissue or fluid into the surrounding abdominal cavity, and (3) the ends of the colon for anastomosis can be prepared for stapling, gluing or otherwise re-joining the bowel in a circumferential manner. These features reduce the risks of the tumour seeding to adjacent sites, since the bowel lumen is never open to the remainder of the abdominal cavity.

Here, independent claim 31, and dependent claims 32, 33, 35, 37, 38, and 43 of the present application are not obvious over the cited references. Assuming, *arguendo*, that the Examiner has properly combined the cited references for his §103(a) rejections; the resulting combination would still not be the claimed invention because such references do not disclose or suggest a method of treating a tumour in a colon wherein a space in the colon within which the tumour to be treated is located, and within which at least the active electrode of the electrosurgical system is located, is enclosed in a substantially fluid-tight manner, as recited in independent claim 31.

Eggers ('592) generally discloses and/or claims a saline fed electrosurgical probe and a method for applying electrical energy to a target site on a body structure. Eggers ('592) does not describe a method of treating a tumour in a colon, much less one

wherein a space in the colon within which the tumour to be treated is located, and within which at least the active electrode of an electrosurgical system is located, is enclosed in a substantially fluid-tight manner. At most, Eggers ('592) makes a passing reference to using the "system and method of the present invention . . . to efficaciously ablate . . . cancer on the surface of the . . . colon . . . and the like." Eggers ('592), col. 23, lns. 60 – 64. No particular details of the colon treatment are disclosed in Eggers ('592).

The Examiner acknowledges, but seeks to overcome, the deficiency in Eggers ('592)'s teachings by pointing to Hart *et al.* ('992) as disclosing "an anatomical cavity (an enclosed space)" which the Examiner argues "can include a surgically induced cavity in the colon." Office Action, p. 3. To support his argument, the Examiner compares Figure 10 of Hart with Figure 10 of the present application. It should be noted, however, that the colon treatment method of the present invention is exemplified in Figure 15 of the present application, and not Figure 10, which relates to subject matter claimed in the parent application to the present application.

Hart *et al.* ('992) does not disclose a method of treating a tumour in a colon, much less one wherein a space in the colon within which the tumour to be treated is located, and within which at least the active electrode of an electrosurgical system is located, is enclosed in a substantially fluid-type manner. Hart discloses a surgical access device for providing gas-tight communication to an anatomical cavity which facilitates the insertion and use of surgical instruments while maintaining the anatomical cavity. The surgical access device disclosed in Hart is used to isolate and maintain a surgically made superfascial incision (*i.e.*, just under the skin), and for providing a

sealed access path into an operable region in communication with the incision. The surgical access device includes a flexible base which is removably attached to a portion of the skin adjacent to the incision. The base includes an opening for isolating the incision and an outer peripheral edge. A generally hollow stem surrounds the opening and extends outwardly from the base. The stem includes a passageway extending along the length of the stem and communicating with the opening in the flexible base. An instrument seal is attached to the stem within the passageway for providing a seal around an instrument which may be inserted through the instrument seal. A valve is attached within the hollow stem for maintaining a gas-tight barrier across the passageway. Both the instrument seal and the valve are penetrable by the instrument.

See, Hart, col. 3, Ins. 28-46.

Hart does not envisage treatment of a tumour in a colon, since his surgical access device is designed to be used with superficial incisions. Hart shows his surgical access device being used with conventional (non-electrosurgical) instruments. Because the instruments used with Hart's device are not electrosurgical instruments, Hart also does not teach using his device with a supply of a conductive fluid, such as saline. The gas supplied in Hart is used to insufflate (expand) the surgical cavity. Hart does not teach using the gas with an electrosurgical instrument to complete at least a part of a conduction path between active and return electrodes, as recited in claim 31, much less to treat a tumour in a colon. Thus, Hart cannot compensate for the deficiency in the teachings of the primary Eggers ('592) reference noted above. As such, claim 31 is not obvious over Eggers ('592) in view of Hart *et al.* ('992). And,

GOBLE

Serial No. 10/036,500

Page 15

because rejected claims 32, 33, 35, 36, 37, 38 and 43 depend, either directly or indirectly, from claim 31, such claims are also not obvious over the combination of such references.

In view of the foregoing, it is now believed that all of the claims pending in the application, *i.e.*, claims 31-47, are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contacted the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

Robert A. Molan

Robert A. Molan

Reg. No. 29,834

RAM:dt

1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100